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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/960,665	09/21/2001	Neal Rosen	MSK.P-038-2	5586

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EXAMINER

KIFLE, BRUCK

ART UNIT PAPER NUMBER

1624

DATE MAILED: 07/31/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.
09/960,665

Applicant(s)
Osen et al.

Examiner
Bruck Kifle, Ph.D.

Art Unit
1624



— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —

THE REPLY FILED Jul 21, 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

Therefore, further action by the applicant is required to avoid the abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

THE PERIOD FOR REPLY [check only a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see NOTE below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☐ Applicant's reply has overcome the following rejection(s): _____

4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because:
see attached.

6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____

Claim(s) objected to: _____


Claim(s) rejected: _____

Claim(s) withdrawn from consideration: _____

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.

9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____

10. ☐ Other: _____


BRUCK KIFLE, PH.D.
PRIMARY EXAMINER
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The claims have not been limited to the elected subject matter.

Claims 1, 2, 6, 7 and 12-40 would still be rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention because:

- i) It is still unclear where on the geldanamycins the linker is bonded.
- ii) The nature of the linker is not known.
- iii) In claim 12 and 26-30, it is unclear as to where these cells are that are to be destroyed.

Claims 13-17 and 31-36 would also be rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Undue experimentation is required to use compounds of the instant claims to treat cancers generally or those which over express a HER-family kinase. The specification does not provide enablement for the treatment of cancer generally.

The claims measure the invention. *United Carbon Co. v. Binney & Smith Co.* 55 USPQ 381 at 384, end of first paragraph, Supreme Court of the United States (1942).

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The U.S. Court of claims held to this standard in *Lockhead Aircraft Corp. vs. United States*, 193 USPQ 449, "claims measure the invention and resolution of invention must be based on what is claimed."


The CCPA said "that invention is the subject matter defined by the claims submitted by the applicant". "We have consistently held that no applicant should have limitations of the specification read into a claim where no express statement of the limitation is included in the claim" (*In re Priest*, 199 USPQ 11 at 15).

Therefore Applicants need to indicate in the claim what is intended.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bruck Kifle whose telephone number is (703) 305-4484.

The fax phone number for this Group is (703) 308-4556 or (703) 305-3592. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1235.

July 30, 2003


Bruck Kifle
Primary Examiner
Art Unit 1624